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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,577	06/07/2001	Glen J. Anderson	2121	1357

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/876,577

Applicant(s)

ANDERSON, GLEN J.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-24, 26, 28, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-24, 26, 28, and 30-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/2005 has been entered.

### ***Response to Amendment***

2. Applicant's amendment received on 7/7/2005 is acknowledged and entered. The applicant has amended claims 1, 9, 17, added a new claim 31 and canceled claims 3, 25, 27 and 29. Currently claims 1-2, 4-24, 26, 28 and 30-31 are pending for examination.

### ***Response to Arguments***

3.1 Rejection of claims 1-2 and 4-8 under 35 USC 101 is withdrawn in view of the current amendments made to claim 1.

3.2. Rejection of claims 25, 27 and 29 under 35 USC 112, first paragraph is withdrawn in view of their cancellation.

3.3. Applicant's arguments filed on 7/7/2005 about current amendment to claims 1, 9 and 17 have been fully considered but they are not persuasive. The applicant argues that since now claims 1, 9 and 17 are directed to receiving a system configuration selection including at least two system elements and providing a description of function capable of being implemented with the combination of the two at least said system elements they are different from the prior art of Henson. The examiner respectfully disagrees because Henson does teach configuring a

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computer system made of two or more system elements, see Figs. 3A and 3B which show configuring a computer system made of several system elements, such as Dell SPS R MiniTower, Monitor, Printers, and Scanners and also provides a description of function capable of being implemented with the combination of at least two systems, that is providing function of Dell MiniTower as to deliver tremendous speed to high end applications, for Printers for being capable to print the kid's artwork or output professional quality documents and for scanners to be able to turn hardcopies of photographs and graphics into digital files, etc. This is in line with the applicant's invention as disclosed in Fig.5 A and page 5, lines 13-18 which show selecting two system elements as a printer and a camera and displaying the description of function of each element, that the capabilities of the printer and camera separately for the combined system including printer and camera. Also, claim 31 is similar to claim 1 except for reciting the term "particular" before combination in lines 7 and 11. B adding the "particular" term does not make any difference in the interpretation of two claims 1 and 31 as any combination arrived at by selecting two system elements would result in a particular combination until unless the claim 31 also includes limitations qualifying or defining the "particular" term to mean different from any selected combination of two system elements.

This is a continuation of applicant's earlier Application No. 09/876,577. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.1. Claims 1-2, 4, 8-12, 16-20 and 24 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson.

Regarding claim 1, Henson teaches a method for configuring a build-to-order system (See at least abstract), comprising:

(a) providing a list of configuration choices, presented in a graphical user interface displayed on an information appliance, said list comprising available system elements with which said build-to-order system are configured;

(b) receiving a system configuration selection based on a combination of at least two system elements of said available system elements selected from said list of configuration choices; and

(c) providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection.

(For all the above three limitations see at least col.6, lines 18-43, " *Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options. Selection of*

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*the update price function can be accomplished by clicking on an "UPDATE PRICE" icon 72 on the configuration screen. Upon obtaining a desired configuration, a customer could then select the "ADD TO CART" icon 74 to add the configured system to the shopping cart 20 and continue shopping, as desired. ....* ". Note: In Figs. 3 A, 3 B and 3C Henson provides a list of configuration choices in the form of displaying various choices for selecting a Dell XPS R MiniTower, Monitor, memory, hard drive, monitor, Printers, Scanners, etc., thereby prompting an user to make selections to configure and order a build-to-order computerized system. While presenting the choices, Henson also provides description of functions of the system elements. Henson teaches configuring a computer system made of two or more system elements, see Figs. 3A and 3B which show configuring a computer system made of several system elements, such as Dell SPS R MiniTower, Monitor, Printers, and Scanners and also provides a description of function capable of being implemented with the combination of at least two systems, that is providing function of Dell MiniTower as to deliver tremendous speed to high end applications, for Printers for being capable to print the kid's artwork or output professional quality documents and for scanners to be able to turn hardcopies of photographs and graphics into digital files, etc. This is in line with the applicant's invention as disclosed in Fig.5 A and page 5, lines 13-18 which show selecting two system elements as a printer and a camera and displaying the description of function of each element, that the capabilities of the printer and camera separately for the combined system including printer and camera. Also, see FIG.5 and col.9, lines 9-25)

Regarding claim 2, Henson teaches that the method as claimed in claim 1, further comprising the steps of: (a) receiving an updated system configuration selection; and (b) providing an updated description of a function capable of being implemented with said updated system configuration selection (see at least FIG.3C which discloses that by clicking the icon "

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UPDATE PRICE" on the bottom of Fig.3B the user receives an updated configuration selection with the updated price and functions also because any changes in the options would inherently show descriptions corresponding to the changed options).

Regarding claims 3 and 4, Henson teaches that the method as claimed in claim 1, wherein said list of configuration choices is presented in a graphical user interface and wherein at least one of said available system elements in said list of configuration choices being represented by an icon (see FIG.5 and col.9, lines 9-25 which shows that the options are represented by icons and menus on the screen and that is indicative of the use of a graphical user interface. Figs. 3A, 3B and 3C show the use of menus and dialog boxes and they are indicative of the use of a graphical user interface).

Regarding claim 8, Henson teaches a method for configuring a build to order system as analyzed and discussed above. Henson further discloses said description of function capable of being implemented with said system configuration selection includes at least one of advantages of said selection and suggestions for other selections (see FIG.3A, " Monitor...Upgrading to a larger monitor....exceptional monitors can deliver enhanced resolution and refreshing rates..... Sound Card .....Storage products....Back up valuable files....FIG.3B, " Scanners...." Wherein Henson describes the advantage of selecting a scanner), suggestions for other selections (see FIG.3B besides suggesting the selection of scanner it also suggests other selections such as, Software and accessories, power protection, etc.. Note: Dell provides a description of a function capable of being implemented, such as for scanners, monitors, storage products and all of these products are components of the computer system being configured).

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Regarding claims 9-12, 16-20, and 24 their limitations are closely parallel to the limitations of claims 1-2, 4 and 8 and are therefore analyzed and rejected on the same basis.

Regarding claim 31, its limitations are similar to the limitations of claim 1 and is therefore analyzed and rejected on the same basis. Claim 31 is similar to claim 1 except for reciting the term " particular" before combination in lines 7 and 11. B adding the "particular" term does not make any difference in the interpretation of two claims 1 and 31 as any combination arrived at by selecting two system elements would result in a particular combination until unless the claim 31 also includes limitations qualifying or defining the " particular" term to mean different from any selected combination of two system elements.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 5-7, 13-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Tuzhilin (US Patent 6,236,978).

Regarding claims 5 & 6, Henson teaches a method for configuring a build to order system as analyzed and discussed in claim 1 above. Henson teaches identifying customers if they belong to a particular customer set (see col.13, lines 30-52) and then presenting the options accordingly. Henson does not disclose the step of developing a personal user history file for each user and including customized information pertaining to each user. However, in the



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same endeavor of e-commerce, Tuzhilin discloses the step of developing a personal user history file for each user (see at least FIGS 1, 2, col.2, lines 24-40, "*The system and method according to the present invention generates dynamic profiles and, thereafter, transforms the dynamic profiles for various users into aggregate rules. ....* "). In View of Tuzhilin, it would have been obvious to a skilled artisan in the art to have modified Henson to incorporate the feature of developing a personal user history file for each user and use this personal history file to provide customized information pertaining to each user because to provide better recommendations to the users as to which product and services each individual user should utilize, as explicitly disclosed in Tuzhilin ( see at least col.2, lines 41-59).

Regarding claim 7, Henson in view of Tuzhilin, as applied to claim 5, teaches a method for configuring a build to order system based upon a personal history file of the user as analyzed above. Henson in view of Tuzhilin, as applied to claim 5, does not disclose that said personal history file includes at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information. However, in the same endeavor of e-commerce, Tuzhilin discloses that said personal history file includes at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information (see at least FIGS 1, 2, col.2, lines 24-59, "*The system and method according to the present invention generates dynamic profiles and, thereafter, transforms the dynamic profiles for various users into aggregate rules. ....* ", and col.1, lines 27-col.2, line 10, "*There are two basic types of user profiles that can be generated-- a "static" profile and a "dynamic" profile. The static profile contains all of the factual information of the user including, for example, demographic data (e.g., age, sex, address), psychographic data (e.g., personality traits and habits), purchasing preferences (e.g., what does the user purchase in an average week), etc. Static profiles are generated using conventional methods that are known to those of ordinary*

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*skill in the art. ....Dynamic profiling information includes specific rules describing the user's behavior. .... In order to obtain an extensive understanding of the user, it is desirable to build both static and dynamic profiles for that user. .... ").* In View of Tuzhilin, it would have been obvious to a skilled artisan in the art to have modified Henson to incorporate the feature of developing a personal user history file for each user by including at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information because to provide better recommendations to the users as to which product and services each individual user should utilize, as explicitly disclosed in Tuzhilin ( see at least col.2, lines 41-59).

Regarding claims 13-15 and 21-23 their limitations are parallel to the limitations of claims 5-7 and are therefore analyzed and rejected on the same basis.

5.2. Claims 26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Tuzhilin and further in view of Roberts et al. (US Patent 6,101,486), hereinafter, referred to Roberts.

Regarding claim 26, Henson in view of Tuzhilin teaches a method for configuring a build to order system using a personal history file as analyzed and discussed above in claim 5. Henson in view of Tuzhilin does not explicitly disclose that the personal history file includes obtaining information about each user's current products and components, wherein said description of function capable of being implemented with said system configuration selection includes comparison information regarding said selection and the user's current products and components. However, in the field of same endeavor, Roberts discloses that the personal history file includes obtaining information about each user's current products and components, wherein said description of function capable of being implemented with said system

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configuration selection includes comparison information regarding said selection and the user's current products and components (see at least abstract and col.6, line 12-col.7, line 55, ".....A comparison between the customer profile and the company database is performed to create a listing of products or services not currently owned or used by the customer (Step 440). Preferably, the customer profile includes a listing of services and products currently possessed by the customer. This first comparison generates a product list that includes products within the company's database that are not currently owned by the customer and of potential interest to the customer..... Likewise, if a customer has already purchased a particular product from the company, the comparison would identify products and services that could operate in conjunction with, or offer improvements over, the customer's current inventory of products and services. ...." ). In View of Roberts, it would have been obvious to a skilled artisan in the art to have modified Henson in view of Tuzhilin to incorporate the feature that the personal history file includes obtaining information about each user's current products and components, wherein said description of function capable of being implemented with said system configuration selection includes comparison information regarding said selection and the user's current products and components because the customized service based upon the gathered user's profile on current products and components would serve the specific needs and interests of the user better, see Roberts col.6, lines 12-16).

Regarding claims 28 and 30 their limitations are parallel to the limitations of claim 26 and are therefore analyzed and rejected on the same basis.

### **Conclusion**

6. This is a continuation of applicant's earlier Application No. 09/876,577. All claims are drawn to the same invention claimed in the earlier application and could have been finally

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rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

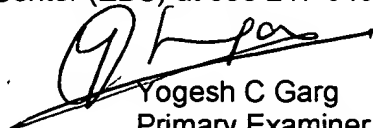
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
September 9, 2005